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--25. (New) The video game storage medium of claim 8, further comprising program code for repeatedly outputting the prompt when the player fails to match the key operation corresponding to the special action suggested by the prompt.--

REMARKS

In the last Office Action, the Examiner: rejected claims 1-24 under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification; rejected claims 7, 8, 17, and 18 under 35 U.S.C. § 112, second paragraph for being indefinite; rejected claims 1, 7, 8, 15, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,241,524 to Aoshima et al. ("Aoshima"); and rejected claims 2-6, 9-14, 16, and 19-24 as unpatentable over Aoshima in view of U.S. Patent No. 6,149,523 to Yamada ("Yamada"). By this Amendment, Applicants propose adding new claim 25 and amending claims 1-2, 7-8, 15, and 17-24. Therefore, upon entry of this Amendment, claims 1-25 will be currently pending.

Consideration of References cited in the Supplemental Information Disclosure Statement of August 26, 2002

In the last Office Action, the Examiner indicated that she did not consider the references cited in the Supplemental Information Disclosure Statement ("IDS") filed August 26, 2002. In lieu of a statement of relevance or translation, Applicants submitted an English-language version of a search report from the Japanese Patent Office setting forth the relevance of the enclosed documents. However, the Examiner states that an English-language version of a search report Japanese Patent Office cannot be found in the file. Accordingly, as a courtesy to the Examiner, Applicants submit herewith another copy of the Supplemental IDS and the English-language version of the Japanese

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search report and a stamped postcard indicating that these papers were received by the U.S. Patent and Trademark Office. Applicants therefore request that the Examiner consider the documents cited in the Supplemental IDS.

Rejection of claims 1-24 under 35 U.S.C. § 112, first paragraph

In the last Office Action, the Examiner rejected claims 1-24 under 35 U.S.C. § 112, first paragraph as containing subject matter, which was not described in the specification. Applicants respectfully traverse this rejection.

Specifically, regarding claims 1 and 15, the Examiner asserts that the specification does not disclose a "special action to which the user is given prompts was never before operable during a game," but which becomes operable for the first time in the game. In addition, regarding claims 6 and 16, the Examiner asserts that the specification does not disclose that each key action is shown by the actions of a displayed object. Applicants respectfully disagree.

Claim 1 recites, *inter alia*, an image processing apparatus. A prompt processing means outputs a prompt which provides training for a key operation corresponding to a special action of a game. In addition, claim 15 recites, *inter alia*, outputting a prompt which provides training for a key operation corresponding to a special action of a game. Before the prompt is provided to the player, the special action of the game is not operable. The special action of the game becomes operable for the first time in the game after the prompt suggests the key operation to the player and the player correctly matches the key operation corresponding to the special action suggested by the prompt.

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The specification describes such a feature at, for example, pages 14-20. A practice mode is actuated by a player when the player meets a practice character during progress of a game. (See specification at page 14, lines 14-17). The practice mode is a training mode for key operations, such as a key operation corresponding to a special action or technique. (Id.). At the request of the player, the practice character trains the player on how to perform a special action. (See specification at page 14, line 20 through page 15, line 2). The training includes one or more prompts that instruct the player on the key operation for performing a particular special action or technique (See specification at page 17, lines 12-20). The operating procedures for the special techniques are "hidden" in these prompts. (See specification at page 19, lines 18-22). That is, the operating procedures for a special technique are not operable (i.e., "hidden") until after the prompt is provided to the player and the player gains proficiency in matching a key operation for the special technique. Therefore, Applicants respectfully submit that the specification discloses at least one example of the features of claim 1 and 15.

Claims 6 and 16 recite, *inter alia*, each key operation "is output in a prompt while being shown by the actions of the displayed object." The specification also describes at least one example of this feature. For example, the specification describes at page 15, lines 4-18 a "practice character" that shows the actions for performing one or more key operations corresponding to prompts. Therefore, Applicants respectfully submit that the specification discloses at least one example of the features of claims 6 and 16.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection to claims 1-24.

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Rejection of claims 7, 8, 17, and 18 under 35 U.S.C. § 112, second paragraph

In the last Office Action, the Examiner rejected claims 7, 8, 17, and 18 under 35 U.S.C. § 112, second paragraph for being indefinite. Applicants respectfully traverse this rejection.

In particular, Applicants have reviewed and, where appropriate, amended claims 7, 8, 17, and 18 to clarify the recited features. Accordingly, Applicants respectfully request and reconsideration and withdrawal of the rejection.

Rejection of claims 1, 7, 8, 15, 17, and 18 under 35 U.S.C. § 103(a) over Aoshima

In the last Office Action, the Examiner rejected claims 1, 7, 8, 15, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over Aoshima. Applicants respectfully traverse this rejection.

Claim 1 recites, *inter alia*, an image processing apparatus comprising an image processing means. The image processing means comprises a prompt processing means for outputting a prompt which provides training for a key operation corresponding to a special action of a game which was never before operable during the game. The prompt relates to an action other than the special action and suggests the key operation to the player via output means, such that the special action becomes operable for the first time in the game after the player correctly matches the key operation corresponding to the special action suggested by the prompt.

The Examiner correctly acknowledges that Aoshima fails to teach a special action of a game which was never before operable during a game and becomes

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operable for the first time in the game after a prompt suggests a key operation for the special action. (See Office Action at page 5, para. 2). However, the Examiner alleges that Aoshima "axiomatically" teaches such a feature. Applicants respectfully disagree.

Aoshima merely teaches a game apparatus that uses an operational state judging section for judging an operational state from an operation history of the player to select advice data appropriate to the player (See Aoshima, col. 2, lines 46-50). Skilled players may therefore selectively proceed through a game without receiving the advice that is meant for beginners (See Aoshima, col. 3, lines 1-22). In particular, a skilled player may command an "advice terminating means" that prevents advice messages from being displayed in an advice window. (See Aoshima, col. 5, lines 30-34). In other words, Aoshima's game apparatus allows a skilled player to perform all the operations known to him without receiving any advice.

In contrast, claim 1 recites a prompt processing means for outputting a prompt which provides training for a key operation corresponding to a special action of a game which was never before operable during a game. After the prompt suggests the key operation for the special action, the special action becomes operable for the first time in the game after the player is able to correctly match the key operation corresponding to the special action suggested by the prompt. In other words, according to claim 1, a special action is not operable during a game until after a prompt provides training for the special action and suggests the key operation for the special action and after the player correctly matches the key operation corresponding to the special action suggested by the prompt. Therefore, Applicants have advised the undersigned that even if a player has learned the key operation for a special action from previous experience, the special

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action is not operable in a game until after the player has demonstrated proficiency over the special action, such as proficiency in matching the key operation corresponding to the special action, during the training provided by the prompt.

Aoshima fails to teach such a feature. Instead, Aoshima teaches a game apparatus that allows a skilled player to use any operation without receiving any advice or training. Indeed, Aoshima teaches away from the features of claim 1, because if a skilled player shows proficiency over an operation, then Aoshima's game apparatus does not provide any advice and allows the skilled player to proceed through the game. (See Aoshima, col. 12, lines 51-63). Claim 1, on the other hand, recites that a special action is not operable during a game until after a prompt provides training for the special action and suggests the key operation for the special action to the player and after the player correctly matches the key operation corresponding to the special action suggested by the prompt. Therefore, Aoshima fails to teach or suggest (axiomatically or otherwise) all the features of claim 1.

Claim 8 recites, *inter alia*, program code for outputting a prompt which provides training for a key operation corresponding to a special action of a game which was never before operable during the game. The prompt relates to an action other than the special action and suggesting the key operation to the player via output means, such that the special action becomes operable for the first time in the game and after the player correctly matches the key operation corresponding to the special action suggested by the prompt. Claim 15 recites, *inter alia*, outputting a prompt which provides training for a key operation corresponding to a special action of a game which was never before operable during the game. The prompt relates to an action other than

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the special action and suggesting the key operation to a player, such that the special action becomes operable for the first time in the game after the player correctly matches the key operation corresponding to the special action suggested by the prompt. Claim 18 recites, *inter alia*, program code for outputting a prompt which provides training for a key operation corresponding to a special action of a game which was never before operable during the game. The prompt relates to an action other than the special action and suggesting the key operation to a player, such that the special action becomes operable for the first time in the game after the player correctly matches the key operation corresponding to the special action suggested by the prompt.

As explained above with respect to claim 1, Aoshima fails to teach or suggest at least this feature. Therefore, Aoshima also fails to teach or suggest all the features of claims 8, 15, and 18.

Claims 7 and 17, by virtue of their dependency from claim 1, include at least the same features recited in claim 1. Therefore, claims 7 and 17 are allowable for at least the same reasons that claim 1 is allowable, as well as for their additional recitations.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection to claims 1, 7, 8, 15, 17, and 18.

Rejection of claims 2-6, 9-14, 16, and 19-24 under 35 U.S.C. § 103(a) over Aoshima in view of Yamada

In the last Office Action, the Examiner rejected claims 2-6, 9-14, and 19-24 as unpatentable over Aoshima in view of Yamada. Applicants respectfully traverse this rejection.

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The Examiner correctly acknowledges that Aoshima fails to teach all the features of claims 2-6, 9-14, and 19-24. However, the Examiner alleges that it would have been obvious to combine Aoshima and Yamada to arrive at the features of claims 2-6, 9-14, and 19-24. Applicants respectfully disagree.

Yamada fails to cure the deficiencies of Aoshima. Yamada merely teaches a game machine which provides an image synthesis method for synthesizing a game image and determines whether or not an input sequence matches a given standard sequence. (See Yamada, col. 1, lines 51-55). In particular, Yamada teaches a game device that includes a "training mode" that provides visual feedback to a user in order to learn a "special technique." (See Yamada, col. 2, lines 46-60; Figs. 1B and 1C). In the training mode, Yamada's game device displays controller sequences and indicates which input operations for the special technique were successful. (See Yamada, col. 5, lines 55-59). The special techniques are available to the user at any time in order to have an advantage over an opponent in the game. (See Yamada, col. 4, lines 54-61.)

In contrast, claims 2-6, by virtue of their dependency from claim 1, recite, *inter alia*, a prompt processing means for outputting a prompt which provides training for a key operation corresponding to a special action of a game which was never before operable during the game. The prompt relates to an action other than the special action and suggests the key operation to the player via output means, such that the special action becomes operable for the first time in the game after the player correctly matches the key operation corresponding to the special action suggested by the prompt.

Yamada fails to teach such a feature. As explained above, Yamada's game device merely includes a training mode to allow a user to become familiar with a special

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technique. (See Yamada, col. 2, lines 46-60; Figs. 1B and 1C). In Yamada's game device, once a user has learned a special technique, the user may perform that special technique at any time during the game. (See Yamada, col. 3, lines 54-62.) However, according to claims 2-6, a special action is not operable during a game until after game prompt processing means provides a prompt that provides training for the special action and suggests the key operation for the special action and after the player is able to correctly match the key operation corresponding to the special action suggested by the prompt. Therefore, Yamada also fails to teach or suggest all the features of claims 2-6. In addition, for the same reasons explained above with respect to claims 2-6, Yamada fails also to teach or suggest the features of claims 9-14, 16, and 19-24.

Accordingly, even if Aoshima and Yamada were properly combinable, the combination would still fail to teach or suggest all the features of claims 2-6, 9-14, 16, and 19-24. Applicants therefore request reconsideration and withdrawal of the rejection to claims 2-6, 9-14, 16, and 19-24.

New Claim 25

New claim 25, by virtue of its dependence of claim 8, includes at least the same features recited in claim 8. Therefore, Applicants respectfully submit that claim 25 is allowable for at least the same reasons that claim 8 is allowable, as well as for its additional recitations.

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CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-25 in condition for allowance. Applicants submit that the proposed amendments of claims 1-2, 7-8, 15, and 17-24 and new claim 25 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that entry of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Attached hereto is a marked-up version of the changes made to the claims by this amendment. The attached page is captioned "**Version with markings to show**

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changes made." Deletions appear as normal text surrounded by [] and additions appear as underlined text.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: July 14, 2003

By: _____
Donald D. Min
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claims 1-2, 7-8, 15, and 17-24 as follows:

1. (Twice Amended) An image processing apparatus comprising:

image processing means comprising prompt processing means for outputting a prompt which [indirectly teaches] provides training for a key operation corresponding to a special action of a game which was never before operable during the game, and a determining means for determining whether the player correctly matches the actions of a displayed object according to said prompt processing means,

said prompt relating to an action other than the special action and suggesting the key operation to the player via output means, such that the special action becomes operable for the first time in the game after the player correctly matches the key operation corresponding to the special action suggested by the prompt.

2. (Twice Amended) The image processing apparatus, according to claim 1, wherein said image processing means further comprises:

recognition means for recognizing key operations by said player[; and

determining means for determining whether the key operations by the player match the actions of a displayed object according to said prompt processing means].

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7. (Twice Amended) [An electronic game apparatus comprising the] The image processing apparatus according to any of claims 2 through 3, wherein the image processing apparatus is configured as electronic game apparatus.

8. (Twice Amended) A video game storage medium [wherein is stored a] that stores program code for executing [the] an image processing [means according to any of claims 2 through 3] method, said medium comprising:

program code for recognizing key operations by a player;

program code for outputting a prompt which provides training for a key operation corresponding to a special action of a game which was never before operable during the game, said prompt relating to an action other than the special action and suggesting the key operation to the player via output means, such that the special action becomes operable for the first time in the game after the player correctly matches the key operation corresponding to the special action suggested by the prompt; and

program code for determining whether the player correctly matches the key operation corresponding to the special action suggested by the prompt.

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15. (Once Amended) An image processing method comprising:

outputting a prompt which [indirectly teaches] provides training for a key operation corresponding to a special action of a game which was never before operable during the game, said prompt relating to an action other than the special action and suggesting the key operation to a player, such that the special action becomes operable for the first time in the game after the player correctly matches the key operation corresponding to the special action suggested by the prompt.

17. (Once Amended) [An electronic game apparatus comprising the] The image processing apparatus according to claim 1, wherein the image processing apparatus is configured as an electronic game apparatus.

18. (Once Amended) A video game storage medium [wherein is stored] that stores [a] program code for executing [the] an image processing [means according to claim 1] method, said medium comprising:

program code for outputting a prompt which provides training for a key operation corresponding to a special action of a game which was never before operable during the game, said prompt relating to an action other than the special action and suggesting the key operation to a player, such that the special action becomes operable for the first time in the game after the player correctly matches the key operation corresponding to the special action suggested by the prompt.

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19. (Once Amended) The image processing apparatus according to claim 16, wherein said image processing means displays symbols for a plurality of keys to be operated on a sub-screen, according to the results of a determination of a match by [a] the determining means.

20. (Once Amended) The image processing apparatus according to claim 16, wherein said image processing means displays symbols for a plurality of keys to be operated on a sub-screen, according to the results of a determination of a match by [a] the determining means, and further wherein said sub-screen display is executed in the case when a match is not affirmed even when said match determination is made for a plurality of times.

21. (Once Amended) The image processing apparatus according to claim 17, wherein said image processing means displays symbols for a plurality of keys to be operated on a sub-screen, according to the results of a determination of a match by [a] the determining means.

22. (Once Amended) The image processing apparatus according to claim 17, wherein said image processing means displays symbols for a plurality of keys to be operated on a sub-screen, according to the results of a determination of a match by [a] the determining means, and further wherein said sub-screen display is executed in the case when a match is not affirmed even when said match determination is made for a plurality of times.

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23. (Once Amended) The image processing apparatus according to claim 18, wherein said image processing means displays symbols for a plurality of keys to be operated on a sub-screen, according to the results of a determination of a match by [a] the determining means.

24. (Once Amended) The image processing apparatus according to claim 18, wherein said image processing means displays symbols for a plurality of keys to be operated on a sub-screen, according to the results of a determination of a match by [a] the determining means, and further wherein said sub-screen display is executed in the case when a match is not affirmed even when said match determination is made for a plurality of times.

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